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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,651	07/12/2001	Hiroynki Nakane	77670/495	2816

7590

04/18/2006

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EXAMINER

STEADMAN, DAVID J

ART UNIT

PAPER NUMBER

1656

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/902,651

Applicant(s)

NAKANE ET AL.

Examiner

David J. Steadman

Art Unit

1656

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 31 January 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment. (See 37 CFR 1.116 and 41.33(a)).

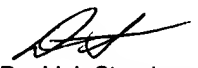
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-32.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


David J. Steadman, Ph.D.
Primary Examiner
Art Unit: 1656

ADVISORY ACTION

[1] The request for reconsideration in the reply filed on 3/31/2006 has been considered, however the amendment does not place the application in condition for allowance.

[2] The amendment to the claims has not been entered because the claims as amended raise the issue of new matter and require further consideration. See MPEP § 714.13.

[3] For example, claim 1 has been amended to limit the "region II" of the mutant prenyl diphosphate synthase to being "greater than about 25% homologous with the sequence comprising positions 72 through 93 of SEQ ID NO:2." First, it is noted that this limitation has yet to be presented in an amendment under consideration. Thus, for this reason alone the amendment would require further consideration. Second, it is noted that it is unclear as to "*the* sequence comprising positions 72 through 93 of SEQ ID NO:2" (emphasis added) that is encompassed by the claim. In view of the transitional phrase "comprising," the sequence can be any amino acid sequence that happens to comprise amino acids 72-93, however it is unclear as to the *particular* sequence that is intended as being encompassed by the term. Also, it is noted that this limitation would appear to raise the issue of new matter. As support for this limitation, applicant asserts (p. 16 of the instant response) "[s]upport for the percent homology limitation of the claims...is found in all of the prenyl diphosphate synthase sequences disclosed in the application" and is further supported by the references of Chen et al. and Kelly et al. However, while specific "species" of prenyl diphosphate synthase "region II" sequences

Art Unit: 1656

disclosed in the specification may share 25% homology with SEQ ID NO:2, these disclosed "species" do not support the "genus" of any "region II" sequences having "greater than about" 25% homology to a sequence comprising amino acids 72-93 of SEQ ID NO:2. It is further noted that even if Chen et al. provides support for the limitation at issue, it appears that the reference of Chen et al. is not properly incorporated by reference. Also, regardless of whether Kelly et al. discloses information that may have been "well known in the art at the time the application was filed," it does not appear that Kelly et al. is cited in the original application and it follows that Kelly et al. is not properly incorporated by reference. Furthermore, regarding the reference of Kelly et al., according to MPEP § 716.01, "[e]vidence traversing rejections must be timely or seasonably filed to be entered and entitled to consideration. *In re Rothermel*, 276 F.2d 393, 125 USPQ 328 (CCPA 1960). Affidavits and declarations submitted under 37 CFR 1.132 and other evidence traversing rejections are considered timely if submitted: (1) prior to a final rejection, (2) before appeal in an application not having a final rejection, (3) after final rejection, but before or on the same date of filing an appeal, upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented in compliance with 37 CFR 1.116(e); or (4) after the prosecution is closed (e.g., after a final rejection, after appeal, or after allowance) if applicant files the affidavit or other evidence with a request for continued examination (RCE) under 37 CFR 1.114 in a utility or plant application filed on or after June 8, 1995; or a continued prosecution application (CPA) under 37 CFR 1.53(d) in a design application" (emphasis added). Applicant's evidentiary reference is submitted

Art Unit: 1656

after a final rejection, however, applicant has satisfied neither of (3) or (4) above for the evidence to be entered and considered by the examiner.

[4] Applicant's arguments in the amendment filed on 3/31/2006 have been fully considered. However, in view of the non-entry of the amendment, applicant's arguments are not found persuasive to overcome the outstanding rejection(s) as set forth in the final Office action mailed on 1/3/2006 for the reasons of record stated therein.

[5] In view of the non-entry of the amendment, the claim status is as follows:

Claims 1-32 are pending.

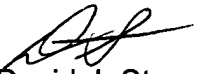
Claims 1-32 are rejected.

No claim is in condition for allowance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Steadman whose telephone number is 571-272-0942. The examiner can normally be reached on Mon to Fri, 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Kerr can be reached on 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David J. Steadman, Ph.D.
Primary Examiner
Art Unit 1656